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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,650	12/29/2000	Peter M. Dickstein	05284-P001	1500
20872	7590	02/02/2006	EXAMINER	
MORRISON & FOERSTER LLP 425 MARKET STREET SAN FRANCISCO, CA 94105-2482			KYLE, CHARLES R	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,650

Applicant(s)

DICKSTEIN ET AL.

Examiner

Charles Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 79-84, 87-90, 95-97, 99, 100, 102, 104, 106, 108 and 109 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 79-84, 87-90, 95-97, 99, 100, 102, 104, 106, 108 and 109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 79-84, 87-90, 95-97, 99-100, 102, 104, 106 and 108-109 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' amended claim language recites limitations whereby a vesting schedule is determined/calculated after accessing company restrictions, a person's record and government restrictions from a database. The Examiner has thoroughly reviewed the Specification and does not find these disclosed. The closest related information regarding vesting schedules is at paras 33, 36, 40 and 41 and Fig. 7 and the recited limitations are no present. This is made clear at Fig. 7, where the vesting schedule is determined at ele. 714 "Associate VS"; none of company restrictions, a person's record or government restrictions are utilized in the "association" of the vesting schedule.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 79-80, 82-83, 87, 89-90, 95-97, 99, 101-102, 104 and 108-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,411,939 *Parsons*.

As to Claim 79, *Parsons* discloses the invention as claimed including in a computer-implemented method for facilitating comprehensive and integrated management and administration of changes to a company's capitalization structure (Background of the Invention, particularly Col. 1, lines 48-54), steps of:

initiating a capitalization-affecting request using an input device by a person or on behalf of the person (Fig. 1, ele. 7, Col. 9, lines 36-38; Fig. 10, eles. 281, 282, 284, 286, 288, 289; Col. 27, line 39 to Col. 28, line 34);

automatically determining a vesting schedule particular for the person in response to the capitalization-affecting request using an administration software in communication with the input device wherein automatically determining the vesting schedule includes (Fig. 36, ele. 1158; Col. 58, line 43 to Co. 60, line 14, particularly, Col. 59, lines 13-15);

accessing company restrictions relating to the capitalization-affecting request from a database in communication with the administration software (Fig. 11, eles. 290, 292; Col. 28, lines 38-45);

accessing a record of the person relating to the capitalization-affecting request

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from the database (Fig. 36, eles. 1154, 1160, 1162, 1170; Col. 58, line 43 to Col. 59, line 38);

accessing governmental restrictions relating to the capitalization-affecting request and the record from the database (Col. 20, line 20 to Col. 21, line 16; Col. 59, lines 56-60);

automatically uniquely classifying the capitalization-affecting request with respect to the person based on the accessed company restrictions, accessed record and accessed governmental restrictions using the administrative software (Col. 29, lines 58-61);

automatically updating the record of the person stored at the database (Fig. 36, ele. 1168; Col. 59, lines 29-33); and

automatically updating the company's capitalization structure stored at the database. (Fig. 12, eles. 310, 312, 314, 316, 318, 320, 322, 334; Col. 29, line 40 to Col. 30, line 62).

Parsons does not specifically disclose that records updating is done in accordance with a vesting schedule. Official Notice is taken that it was old and well known to consider the effects of such events as vesting to maintain updated records. For example, if an incentive stock option, such as that disclosed by *Parsons*, became vested for a participant, generally accepted accounting principles would require that company capitalization and personnel records be updated accordingly so as to accurately represent the financial condition of the issuing company. It would have been obvious to one of ordinary skill in that art at the time of the invention to modify *Parsons* to update records according to a relevant vesting schedule to fairly represent the results of financial operations for a period and to allow preparation of financial statements in accordance with generally accepted accounting principles.

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As to Claim 80, *Parsons* discloses sales transactions at Col. 42, lines 61-67.

Concerning Claims 82-83, *Parsons* discloses a revised balance sheet at Col. 15, line 58 to Col. 16, line 4, at least.

Concerning Claim 87, *Parsons* discloses use of the Internet at Summary of the Invention.

With respect to Claim 89, *Parsons* discloses an employee at Background and Summary of the Invention. See also Fig. 1, ele. 7, Col. 9, lines 36-38.

With respect to Claim 90, *Parsons* further discloses an administrator at Fig 15 and Col. 34, line 44 to Col. 36, line 5.

With respect to Claims 95 and 96, see the discussion of Claim 79 and *Parsons* further discloses a device configured to transmit security transaction requests at Col. 13, lines 29-35, and a database including execution status of previous security transactions requested by the user at Fig. 33, ele. 1010.

With respect to Claims 101-102, Official Notice is taken that payment screens in user interfaces were old and well known at the time of the invention. For example, securities trading work stations provided such functionality. It would have been obvious to one of ordinary skill in that art at the time of the invention to modify *Parsons* to include such screens to inform user/administrators of payment activity related to user transactions.

With respect to Claim 97, see the discussion of Claims 95 and 87.

With respect to Claim 99, see the discussion of Claims 95 and 89.

As to Claim 104, *Parsons* discloses options at Background of the Invention.

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As to Claim 108, *Parsons* discloses generating a report reflecting changes to capitalization structure, a balance sheet, at Fig. 15, ele. 414.

As to Claim 109, *Parsons* discloses a granted status for a securities transaction at Col. 16, lines 5-14.

Claims 84, 100 and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,411,939 *Parsons* in view of *Dictionary of Finance and Investment Terms*, hereinafter, *Dictionary*.

As to Claim 84, *Parsons* discloses the invention substantially as claimed. See the discussion of Claim 79. *Parsons* does not specifically disclose that a board must approve capitalization structure of a company. *Dictionary* discloses this limitation at page 57, "Board of Directors". It would have been obvious to one of ordinary skill in that art at the time of the invention to modify *Parsons* to include the approval of capitalization status of *Dictionary* because this would provide oversight of capitalization of the company.

As to Claim 100, *Dictionary* discloses limitation of transaction requests of Directors (insiders) at page 57, "Board of Directors".

With respect to Claim 106, see the discussion of Claims 95 and 84.

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Claims 81 and 88 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,411,939 *Parsons* in view of *SEC EDGAR Submission 0001012870-98-001814*, hereinafter *SEC2*, already of record.

With respect to Claim 81, see the discussion of Claim 88 and *SEC2* discloses reporting of “what-if”, (i.e., pro forma) capitalization affecting activity at pages 9-10, bracketed text.

Concerning Claim 88, *Parsons* does not specifically disclose a transfer agent. *SEC2* discloses interfacing with a transfer agent at page 81. It would have been obvious to one of ordinary skill in that art at the time of the invention to modify *Parsons* to use the transfer agent of *SEC2* because to maintain proper securities transaction records. Not interfacing with the transfer agent absent a grant would be obvious because there would be no legal way for the agent to transfer securities before grant.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (571) 272-6746. The examiner can normally be reached on 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk
January 27, 2006

Primary Examiner
Charles Kyle
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A handwritten signature in cursive script, appearing to read "Charles Kyle", followed by a stylized flourish.